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EXAMINER

SUBRAMANIAN, NARAYANSWAMY

ART UNIT PAPER NUMBER

3624

DATE MAILED: 10/21/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/653,595

Applicant(s)

TRITZ ET AL.

Examiner

Narayanswamy Subramanian

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 April 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 and 17-38 is/are pending in the application.
- 4a) Of the above claim(s) 17-25 and 33-38 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 17-25 and 33-38 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4,5,7,9, 10, 10/26 6) ☐ Other: _____

DETAILED ACTION

1. Claims 1-9 and 17-38 are pending in this application. Of these, Claims 1-9 and 26-32 have been examined. The restrictions and rejections are stated below.

Election/Restrictions

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-9 and 26-32, drawn to a method and a computer-readable medium storing computer-readable instructions for automatically evaluating a financial account applicant for a financial institution, the method comprising the acts of accessing credit bureau data for the applicant; accessing account information for the applicant; generating a score for the applicant based on the credit bureau data and the account information; and determining whether to open the financial account based on the score, classified in class 705, subclass 36.

II. Claims 17-25, drawn to a system for automatically evaluating a financial account applicant, the system comprising: a system server including a software program for evaluating applicant credit bureau data and applicant account information; a credit bureau database connected to the system server for providing credit bureau data to the software program; a financial account database connected to the system server for providing applicant account information to the software program; and a financial institution computer connected to the system server to provide applicant information to the system server thereby allowing the system server to retrieve applicant credit bureau data and applicant account information and evaluate whether to open the account for the applicant, classified in class 705, subclass 36.

III. Claim 33, drawn to a computer-implemented method of automatically evaluating a financial account applicant for a financial institution, the method comprising the acts of:

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accessing a computer network to retrieve preliminary account information for the applicant to determine if the applicant had an account closed "for cause," the preliminary account information being stored in an account information database; if the applicant had an account closed "for cause," terminating the evaluation; if the applicant did not have an account closed "for cause," accessing the computer network to retrieve credit bureau data and account information for the applicant, the credit bureau data being stored in a credit bureau database and the account information being stored in the account information database; generating with a computer a score for the applicant based on the credit bureau data and the account information; and determining with a computer whether to open the financial account based on the score, classified in class 705, subclass 36.

IV. Claims 34, 35 and 38, drawn to a computer-implemented method of automatically evaluating a financial account applicant for a financial institution including new financial applicant having no existing financial account with the financial institution, the method comprising the acts of accessing a computer network to retrieve credit bureau data for the applicant, the credit bureau data being stored in a credit bureau database; accessing the computer network to retrieve account information for the applicant, the account information being stored in an account information database; generating with a computer a score for the applicant based on the credit bureau data and the account information; generating with a computer pre-established guidelines; comparing with a computer the score to the pre-established guidelines to establish a comparison; and determining with a computer whether to open the financial account based on the comparison, classified in class 705, subclass 36.

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V. Claims 36-37, drawn to a computer-implemented method of offering a product to a financial account applicant, the method comprising the acts of: applying for a financial product; accessing a computer network to retrieve information about the applicant; and offering the applicant a product different than the financial product, classified in class 705, subclass 36.

The inventions are distinct, each from the other because of the following reasons:

3. Inventions I and II are related as sub combinations disclosed as usable together in a single combination. The sub combinations are distinct from each other if they are shown to be separately usable. In the instant case, invention I relates to a method and a computer-readable medium storing computer-readable instructions for automatically evaluating a financial account applicant for a financial institution, the method comprising the acts of accessing credit bureau data for the applicant; accessing account information for the applicant; generating a score for the applicant based on the credit bureau data and the account information; and determining whether to open the financial account based on the score, whereas invention II relates to a system for automatically evaluating a financial account applicant, the system comprising: a system server including a software program for evaluating applicant credit bureau data and applicant account information; a credit bureau database connected to the system server for providing credit bureau data to the software program; a financial account database connected to the system server for providing applicant account information to the software program; and a financial institution computer connected to the system server to provide applicant information to the system server thereby allowing the system server to retrieve applicant credit bureau data and applicant account information and evaluate whether to open the account for the applicant. See MPEP § 806.05(d). Because these inventions are distinct for the reasons given above and the search required for

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Group I is not required for Group II, restriction for examination purposes as indicated is proper even though they are both classified in the same class and subclass.

Inventions I and III are related as sub combinations disclosed as usable together in a single combination. The sub combinations are distinct from each other if they are shown to be separately usable. In the instant case, invention I relates to a method and a computer-readable medium storing computer-readable instructions for automatically evaluating a financial account applicant for a financial institution, the method comprising the acts of accessing credit bureau data for the applicant; accessing account information for the applicant; generating a score for the applicant based on the credit bureau data and the account information; and determining whether to open the financial account based on the score, whereas invention III relates to a computer-implemented method of automatically evaluating a financial account applicant for a financial institution, the method comprising the acts of: accessing a computer network to retrieve preliminary account information for the applicant to determine if the applicant had an account closed "for cause," the preliminary account information being stored in an account information database; if the applicant had an account closed "for cause," terminating the evaluation; if the applicant did not have an account closed "for cause," accessing the computer network to retrieve credit bureau data and account information for the applicant, the credit bureau data being stored in a credit bureau database and the account information being stored in the account information database; generating with a computer a score for the applicant based on the credit bureau data and the account information; and determining with a computer whether to open the financial account based on the score. See MPEP § 806.05(d). Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group III, restriction

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for examination purposes as indicated is proper even though they are both classified in the same class and subclass.

Inventions I and IV are related as sub combinations disclosed as usable together in a single combination. The sub combinations are distinct from each other if they are shown to be separately usable. In the instant case, invention I relates to a method and a computer-readable medium storing computer-readable instructions for automatically evaluating a financial account applicant for a financial institution, the method comprising the acts of accessing credit bureau data for the applicant; accessing account information for the applicant; generating a score for the applicant based on the credit bureau data and the account information; and determining whether to open the financial account based on the score, whereas invention IV relates to a computer-implemented method of automatically evaluating a financial account applicant for a financial institution including new financial applicant having no existing financial account with the financial institution, the method comprising the acts of accessing a computer network to retrieve credit bureau data for the applicant, the credit bureau data being stored in a credit bureau database; accessing the computer network to retrieve account information for the applicant, the account information being stored in an account information database; generating with a computer a score for the applicant based on the credit bureau data and the account information; generating with a computer pre-established guidelines; comparing with a computer the score to the pre-established guidelines to establish a comparison; and determining with a computer whether to open the financial account based on the comparison. See MPEP § 806.05(d). Because these inventions are distinct for the reasons given above and the search required for Group I is not

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required for Group IV, restriction for examination purposes as indicated is proper even though they are both classified in the same class and subclass.

Inventions I and V are related as sub combinations disclosed as usable together in a single combination. The sub combinations are distinct from each other if they are shown to be separately usable. In the instant case, invention I relates to a method and a computer-readable medium storing computer-readable instructions for automatically evaluating a financial account applicant for a financial institution, the method comprising the acts of accessing credit bureau data for the applicant; accessing account information for the applicant; generating a score for the applicant based on the credit bureau data and the account information; and determining whether to open the financial account based on the score, whereas invention V relates to a computer-implemented method of offering a product to a financial account applicant, the method comprising the acts of: applying for a financial product; accessing a computer network to retrieve information about the applicant; and offering the applicant a product different than the financial product. See MPEP § 806.05(d). Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group V, restriction for examination purposes as indicated is proper even though they are both classified in the same class and subclass.

Similarly other pairing of inventions stated above are related as sub combinations disclosed as usable together in a single combination. These inventions are distinct from each other as can be evident from the definition of the groups described above. Also they require separate searches and hence restriction of these inventions for examination purposes as indicated is proper.

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4. After a telephone conversation with Ms. Julie Haut on October 14, 2003 a provisional election was made with traverse to prosecute the invention of Group I namely a method and a computer-readable medium storing computer-readable instructions for automatically evaluating a financial account applicant for a financial institution, claims 1-9 and 26-32. Applicant in replying to this office action must make affirmation of this election. Claims 17-25 and 33-38 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention. Applicant is respectfully advised to cancel the non-elected claims in response to this office action.

Claim Rejections - 35 USC § 101

5. The claims 1, 4 and 5 of the invention are directed to non-statutory subject matter. Claim 1 is drawn to a method of automatically evaluating a financial account applicant for a financial institution that is not tied to any technological art. Similarly the dependent claims 4 and 5 are not tied to any technological art. Claims 1, 4 and 5 of the invention are directed merely to human making mental computations and manually plotting results on paper, and thus are nothing more than an abstract idea, which is not tied to any technological art, and is not a useful art as contemplated by the constitution. The abstract idea does not become a technological art merely by the recitation in the claim of “transforming physical media into a chart” and “physically plotting a point on said chart”. (See Ex parte Bowman, 61 USPQ2d 1669, 1671 (Bd. Pat. App. & Inter. 2001) (Unpublished))

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-9 and 26-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al (US Patent 6,088,686).

With reference to claims 1, 4, 5, 9, 28 and 29, Walker teaches a method and a computer-readable medium storing computer-readable instructions for automatically evaluating a financial account applicant for a financial institution, comprising the acts of: accessing credit bureau data for the applicant; accessing account information for the applicant; generating a score for the applicant; and determining whether to open the financial account based on the score (See Walker Abstract, Column 1 lines 33-40, Column 2 lines 1-21 and Column 3 lines 49-54). The step of accessing credit bureau data for the applicant is inherent in the disclosure of Walker. The computerized system of Walker implies a computer-readable medium storing computer-readable instructions for performing the steps listed in the claim.

Walker does not explicitly teach the step of generating a score for the applicant based on the credit bureau data and the account information.

Official notice is taken that the step of generating a score for the applicant based on credit bureau data; demographic data including income and home ownership; and account information is old and well known in the art. This step enables each financial institution to develop their own scoring model based on weighting of factors they deem important. It also helps them offer products to their customers based on their credit score.

It would have been obvious to one with ordinary skill in the art at the time of the current invention to include the step of generating a score for the applicant based on credit bureau data; demographic data including income and home ownership; and account information to the invention of Walker. The combination of the disclosures taken as a whole suggests that Financial Institutions would have benefited from marketing their products to their clients based on their credit scores.

With reference to claims 2, 3, 26 and 27 Walker teaches a method and a computer-readable medium storing computer-readable instructions of claims 1 and 9 respectively, wherein the act of determining whether to open the financial account includes the acts of establishing electronic guidelines for the financial institution and comparing the guidelines against the score to evaluate whether to accept the application and further comprising the acts of establishing electronic guidelines for the financial institution and comparing the guidelines against the score to evaluate whether to offer additional products and services of the financial institution to the applicant (See Walker Column 2 lines 1-38). The steps of establishing electronic guidelines and comparing the guidelines against the score are inherent in the disclosure of Walker.

With reference to claims 6-8 and 30-32 Walker teaches a method and a computer-readable medium storing computer-readable instructions of claims 1 and 9 respectively as discussed above.

Walker does not explicitly teach the steps of performing a preliminary financial account information database search, denying the applicant if the preliminary financial account database search establishes that the applicant had a previous financial account closed "for cause" or the

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applicant has submitted more than a specified number of financial account applications to financial institutions within a given period of time.

Official notice is taken that the steps of performing a preliminary financial account information database search, denying the applicant if the preliminary financial account database search establishes that the applicant had a previous financial account closed "for cause" or the applicant has submitted more than a specified number of financial account applications to financial institutions within a given period of time are old and well known in the art. These steps help financial institutions screen applicants who may be bad credit risk and also avoid expenses related to accessing credit reports from credit bureaus.

It would have been obvious to one with ordinary skill in the art at the time of the current invention to include the steps of performing a preliminary financial account information database search, denying the applicant if the preliminary financial account database search establishes that the applicant had a previous financial account closed "for cause" or the applicant has submitted more than a specified number of financial account applications to financial institutions within a given period of time to the invention of Walker. The combination of the disclosures taken as a whole suggests that Financial Institutions would have benefited from early screening of applicants who may be bad credit risk and also avoid expenses related to accessing credit reports from credit bureaus.

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dr. Narayanswamy Subramanian whose telephone number is

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(703) 305-4878. The examiner can normally be reached Monday-Thursday from 8:30 AM to 7:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached at (703) 308-1065. The fax number for Formal or Official faxes and Draft or Informal faxes to Technology Center 3600 or this Art Unit is (703) 305-7687. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1113.

N. Subramanian
October 16, 2003

Richard Weisberger
Primary Examiner